Supreme Court, U.S.
FILED
JUL 18 2002
CLERK

No. 02-46

In the

Supreme Court of the United States

JBL, INC. AND INFINITY SYSTEMS CORPORATION,
PETITIONERS,

v.

BOSE CORPORATION,
RESPONDENT.

On Petition for Writ of Certiorari to the United States Court of Appeals for the Federal Circuit

BRIEF FOR RESPONDENT BOSE CORPORATION IN OPPOSITION TO THE PETITION FOR WRIT OF CERTIORARI

CHARLES HIEKEN
COUNSEL OF RECORD
GREGORY MADERA
JOLYNN M. LUSSIER
STEVEN R. KATZ
SHELLEY K. WESSELS
FISH & RICHARDSON P.C.
225 FRANKLIN STREET
Boston, MA 02110-2804
(617) 542-5070
Counsel for Bose Corp.

BlanchardPress, Inc., Boston, Mass. — Law Printers (617) 426-6690

QUESTION PRESENTED

The Federal Circuit Court of Appeals found that the patent claim infringed by Petitioners had not been narrowed during prosecution and affirmed the ruling of the District Court that certain loudspeaker enclosures made and sold by Petitioners infringed the patent claim under the doctrine of equivalents.

The question presented in this case is:

Whether the Federal Circuit Court of Appeals properly affirmed the finding of the District Court that these loudspeaker enclosures infringed under the doctrine of equivalents the patent claim that had not been narrowed during prosecution.

RULE 29.6 STATEMENT

There is no parent or publicly held company owning 10% or more of the stock of Respondent Bose Corporation.

TABLE OF CONTENTS

Page

QUESTION PRESENTED.....i
TABLE OF AUTHORITIES.....iii
RULE 29.6 STATEMENT.....ii
STATEMENT.....1
REASONS WHY THE PETITION SHOULD BE DENIED.....8
1. Neither the Decision below nor the record raises the Question Presented in the Petition 8
2. Since the limitation in issue of the boundary defined by an ellipse was present in originally filed claim 2 that was allowable in independent form and never narrowed during prosecution, the decisions of the courts below are not in conflict with either *Festo* or *Warner-Jenkinson*...11
3. The decision of the Court below was correct because the ports bounded by an ellipse found to have infringed by the doctrine of equivalents differed from a mathematically perfect ellipse de minimus..... 12
CONCLUSION.....13

TABLE OF AUTHORITIES

Cases:
Bose v. JBL, Inc., 112 F.Supp.2d 138 (D.Mass 2000).....4, 12
Bose v. JBL, Inc., 274 F.3d 1354 (Fed. Cir. 2001).....passim

Cases--Continued: Page
Festo Corp. v. Shoketsu Kinzoku Kogyo Kabushiki Co., Ltd., 234 F.3d 558, 56 USPQ2d 1865 (Fed. Cir. 2000).....9, 11
Warner-Jenkinson Co. v. Hilton Davis Chem. Co., 520 U.S. 17, 117 S. Ct. 1040, 137 L.Ed.2d 146 (1997)..... .....9, 11

Miscellaneous:
Brief for the United States as Amicus Curiae Supporting Vacature and Remand, *Festo Corp. v. Shoketsu Kinzoku Kogyo Kabushiki Co.*, ____ U.S. _____, 122 S. Ct. 1831 (2002).....9

In the Supreme Court of the United States

No. 02-46

JBL, INC. AND INFINITY SYSTEMS CORPORATION,

PETITIONERS,

v.

BOSE CORPORATION,

RESPONDENT.

ON PETITION FOR WRIT OF CERTIORARI TO THE UNITED STATES COURT OF APPEALS FOR THE FEDERAL CIRCUIT

BRIEF FOR RESPONDENT BOSE CORPORATION IN OPPOSITION TO THE PETITION FOR WRIT OF CERTIORARI

STATEMENT

Respondent Bose Corporation (Bose) is the owner of U.S. Patent No. 5,714,721 ('721 patent) directed to porting in a loudspeaker system. The Federal Circuit explained:

"Porting" pertains to a port tube inside a loudspeaker enclosure used to radiate acoustic energy from inside the loudspeaker enclosure to an area outside the loudspeaker enclosure at high, crisp audible levels. The design of the port tube is critical in avoiding audible distortion. The specific feature at issue here is the shape of the boundary surrounding the port tube.

The '721 patent consists of six claims: independent claim 1 and dependent claims 2-6. Claims 1-3 are most relevant and read as follows:

1. A loudspeaker enclosure with at least one port for radiating acoustic energy to a region outside said enclosure and having an inside volume,

said at least one port having an axis and characterized by predetermined acoustic mass intercoupling said inside volume and the region outside said enclosure having a smoothly flared input end within said inside volume and a smoothly flared output end adjacent to the region outside said inside volume,

wherein said port defines a boundary between the acoustic mass therein and said inside volume,

said boundary being defined by an ellipse having a major diameter.

> 2. A loudspeaker enclosure in accordance with claim 1 wherein said boundary is defined by the rotation of said ellipse about the axis of said port.
>
> 3. A loudspeaker enclosure in accordance with claim 2 wherein the length of said port corresponds to the major diameter of said ellipse.

'721 patent, col. 2, ll. 33-51 (emphasis added).

Bose's application, which matured into the '721 patent contained nine claims as originally filed: independent claim 1 and dependent claims 2-9. Four of these original claims are relevant to the issue before us:

> 1. A loudspeaker enclosure having an inside volume, and at least one port characterized by predetermined acoustic mass intercoupling said inside volume and the region outside said enclosure having a flared input end within said inside volume and a flared output end adjacent to the region outside said inside volume.
>
> 2. A loudspeaker enclosure in accordance with claim 1 wherein said port defines a boundary between the acoustic mass therein and said inside volume, said boundary being defined by an ellipse.

> 3. A loudspeaker enclosure in accordance with claim 2 wherein said boundary is defined by the rotation of an ellipse about the axis of said port.
>
> 4. A loudspeaker enclosure in accordance with claim 3 wherein the length of said port corresponds substantially to the major diameter of said ellipse.

U.S. Application Serial No. 843,858. Pet. App. 2a-4a, *Bose Corp. v. JBL, Inc.*, 274 F.3d 1354, 1357-58 (Fed. Cir. 2001).

Bose sued Respondents JBL, Inc. and Infinity Systems Corporation (collectively JBL) for patent infringement, claiming that their loudspeaker enclosures included the port technology of the '721 patent.

The District Court, after a jury-waived trial, found 19 JBL products literally infringed, Pet. App. 12a n.1, *Bose v. JBL, Inc.*, 112 F.Supp.2d 138, 141 n.1 (D.Mass. 2000), and the remaining products infringed the '721 patent under the doctrine of equivalents. Pet. App. 30a, 112 F.Supp. at 149.

The District Court said:

> Throughout this trial, JBL has urged me to see the emperor's new clothes. The ports look the same to the naked eye; the laser scans and measurements demonstrate that any differences in the curvature are de minimus. The ports sound the same to the naked ear with respect to the elimination of chuffing; no tests demonstrated perceptible audible differences. In sum, I find that the JBL port tubes defined by the Linear A and exponential curve formulas perform the same function in substantially the same way, with substantially the same result, and therefore infringe the '721 patent under the doctrine of equivalents. Pet. App. 29a-30a, 112 F.Supp. at 149.

The Federal Circuit said:

> An accused device that does not literally infringe a claim may still infringe under the doctrine of equivalents if each limitation of the claim is met in the accused device either literally or equivalently. See *Warner-Jenkinson Co. v. Hilton Davis Chem. Co.*, 520 U.S. 17, 40, 117 S.Ct. 1040, 137 L.Ed.2d 146 (1997). "Prosecution history estoppel serves to limit the doctrine of equivalents by denying equivalency to a claim limitation whose

scope was narrowed during prosecution for reasons related to patentability." *Pioneer Magnetics, Inc. v. Micro Linear Co.*, 238 F.3d 1341, 1344, 57 USPQ2d 1553, 1555 (Fed. Cir. 2001).

To decide whether a claim amendment gives rise to prosecution history estoppel, a court first must determine what claim limitations are alleged to be met by equivalents, whether the limitations at issue were amended during prosecution, and whether a patentee's amendment narrowed the literal scope of the claim. *Festo Corp. v Shoketsu Kinzoku Kogyo Kabushiki Co., Ltd.*, 234 F.3d 558, 586, 56 USPQ2d 1865, 1886 (Fed. Cir. 2000) (*en banc*), *cert. granted*, _____ U.S. _____, 121 S.Ct. 2519, 150 L.Ed.2d 692 (2001). "[A] narrowing amendment made for any reason related to the statutory requirements for a patent will give rise to prosecution history estoppel with respect to the amended claim element." *Id.* at 566, 234 F.3d 558, 56 USPQ2d at 1870.

Bose alleges that the "ellipse having a major diameter" limitation, found in new claim 1 of the '721 patent, can be met by an equivalent and was not narrowed during prosecution. We must review the amendments to original dependent claim 2, which was

rewritten as new claim 1 during prosecution, to determine if Bose narrowed the scope of the claim. It is this new claim 1 which contains the "ellipse having a major diameter" limitation here at issue. As originally filed, claim 2 was objected to as being dependent upon a rejected base claim (original claim 1), but would be allowable if rewritten in independent form to include all of the limitations of the base claim and any intervening claims. After being rewritten as new claim 1, the examiner required Bose to add the phrase "having a major diameter" to provide an antecedent basis for the reference to the term in issued claim 3 (original claim 4), thereby complying with the definiteness requirement of 35 U.S.C. § 112, ¶ 2. JBL argues that this amendment narrowed the claim limitation, and therefore, no range of equivalents is available.

...

Because Bose's amendment did not satisfy the "narrowing amendment" requirement of *Festo*, 234 F.3d at 566, 56 USPQ2d at 1879, we see no need to examine the reason why the applicant amended the claim. The district court properly denied the motion for summary judgment of non-infringement under the doctrine of equivalents because a

> reasonable jury could have returned a verdict for the non-movant. Pet. App. 5a-7a, 274 F.3d at 1358-60.

REASONS WHY THE PETITION SHOULD BE DENIED

1. Neither the Decision below nor the record raises the Question Presented in the Petition.

The sole Question Presented in the Petition (Pet.i.) is, "Does prosecution history estoppel apply to a limitation in an issued patent claim when that claim replaced one in which the patentee amended the same limitation to overcome prior art rejections?" But the Federal Circuit did not decide that question in this proceeding. Moreover, the facts of record will not support a determination of that question by this Court.

As the Federal Circuit correctly observed:

> Bose alleges that the "ellipse having a major diameter" limitation, found in new claim 1 of the '721 patent, can be met by an equivalent and was not narrowed during prosecution. We must review the amendments to original dependent claim 2, which was rewritten as new claim 1 during prosecution, to determine if Bose

> narrowed the scope of the claim. It is this new claim 1 which contains the "ellipse having a major diameter" limitation here at issue. As originally filed, claim 2 was objected to as being dependent upon a rejected base claim (original claim 1), but would be allowable if rewritten in independent form to include all of the limitations of the base claim and any intervening claims. After being rewritten as new claim 1, the examiner required Bose to add the phrase "having a major diameter" to provide an antecedent basis for the reference to the term in issued claim 3 (original claim 4), thereby complying with the definiteness requirement of 35 U.S.C. § 112, ¶ 2. JBL argues that this amendment narrowed the claim limitation, and therefore, no range of equivalents is available. 274 F.3d 1354, 1359 (Fed. Cir. 2001).

Rewriting in independent form originally filed dependent claim 2, allowable as an independent claim, that became claim 1 of the '721 patent, did not narrow the claim and did not result in surrendering subject matter covered by originally filed claim 2.

As the United States said in Brief for the United States as Amicus Curiae Supporting Vacature and Remand, *Festo Corp. v. Shoketsu*

Kinzoku Kogyo Kabushiki Co., _____U.S. _____, 122 S.Ct. 1831 (2002), pp. 16-17:

> Patent applicants may amend their patent claims for reasons of patentability--such as to clarify an ambiguous term--that do not result in narrowing the claims and surrendering subject matter. Rather, the amendments may state the same--or broader--patent claims in more precise terms. For example, an applicant may amend by rewriting a dependent claim as an independent claim. See *Honeywell Int'l Inc. v. Hamilton Sundstrand Corp.*, No. Civ. A. 99-309 GMS, 2001 WL 66348, at *6 (D. Del. Jan. 8, 2001) (citing Festo). Such amendments do not give rise to prosecution history estoppel, which has as its core functions "preserving the notice function of the claims and preventing patent holders from recapturing under the doctrine of equivalents subject matter that was surrendered before the Patent Office." Pet. App. 11a. Patent applicants should not be deterred by the specter of prosecution history estoppel from making amendments that preserve the claimed subject matter but state their claims more precisely and thereby enhance the notice function of the patent claims. Thus, even if a patent claim is amended for reasons of

> patentability, a court should apply prosecution history estoppel only if the particular terms of the amendment narrow the relevant claim.

(Footnotes omitted.)

2. Since the limitation in issue of the boundary defined by an ellipse was present in originally filed claim 2 that was allowable in independent form and never narrowed during prosecution, the decisions of the courts below are not in conflict with either *Festo* or *Warner-Jenkinson*.

Both *Festo* and *Warner-Jenkinson* restrict application of the doctrine of equivalents only if the claim limitation at issue was narrowed during prosecution. *Warner-Jenkinson Co. v. Hilton Davis Chem. Co.*, 520 U.S. 17_____, 117 S.Ct. 1040, 1049-50 (1997); *Festo Corp. v. Shoketsu Kinzoku Kogyo Kabushiki Co.*, ____ U.S. _____, 122 S.Ct. 1831, 1839 (2002). The claim limitation at issue of the boundary defined by an ellipse was present in originally filed claim 2 that was allowable in independent form and not narrowed during prosecution. Thus, the conflict asserted by JBL, Pet. pp. 7-10, with *Festo* and *Warner-Jenkinson* does not exist.

3. The decision of the Court below was correct because the ports bounded by an ellipse found to have infringed by the doctrine of equivalents differed from a mathematically perfect ellipse de minimus.

The District Court found:

> Throughout this trial, JBL has urged me to see the emperor's new clothes. The ports look the same to the naked eye; the laser scans and measurements demonstrate that any differences in the curvature are de minimus. The ports sound the same to the naked ear with respect to the elimination of chuffing; no tests demonstrated perceptible audible differences. In sum, I find that the JBL port tubes defined by the Linear A and exponential curve formulas perform the same function in substantially the same way, with substantially the same result, and therefore infringe the '721 patent under the doctrine of equivalents.

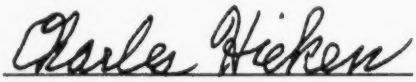
Pet. App. 29a-30a, 112 F.Supp.2d at 149.

It is difficult to conceive of a clearer case of application of the doctrine of equivalents than in this case.

CONCLUSION

For these reasons, the Petition for Writ of Certiorari should be denied.

Respectfully submitted,



Charles Hieken

Counsel of Record
Gregory Madera
Jolynn M. Lussier
Steven R. Katz
Shelley K. Wessels
Fish & Richardson P.C.
225 Franklin Street
Boston, MA 02110-2804
(617) 542-5070
Counsel for Respondent,
Bose Corporation

JULY 2002